

Remarks

Claims 1-14 have been amended to more precisely claim the present invention. No claims have been canceled. Claims 1-14 remain pending in the application.

Information Disclosure Statement

Several references were identified in the related parent patent applications, but not submitted as part of an Information Disclosure Statement. A new Information Disclosure Statement that cites these references from related applications is being submitted along with this Amendment.

Drawings

The Examiner noted that several of the drawings were submitted in informal form. Replacement drawing sheets are being submitted for FIGs. 5-12. Applicant believes that no new matter has been added by these amendments. In view of the replacement drawing sheets, the Applicant believes that the objections to the informal drawings have been overcome. As such, the Applicant respectfully requests that the objections to the drawings be withdrawn.

35 U.S.C. §101

Claims 1 through 9 were rejected under 35 USC 101 as being directed to non-statutory subject matter. In particular, the Examiner stated that the claimed inventions do not fall within the technological art. The Applicant disagrees with the Examiner's assertions concerning non-statutory subject matter of the claims. Claims involving computerized implementations of business methods and methods performed by computer systems have long been held to be statutory subject matter. See for example, State Street v. Signature Financial Group, 47 USPQ 2d 1596 (Fed. Cir. 1998). The claims have been amended to emphasize the use of a coupon redemption in conjunction with performing the method of redeeming coupons. In view of the foregoing, the Applicant requests reconsideration and withdrawal of the rejection of claims 1-9 under 35 USC 101 as being directed to non-statutory subject matter.

35 U.S.C. §103

Claims 1 through 14 were rejected under 35 USC §103(a) as being unpatentable over Rando, et al. 5,128,520. Applicant respectfully suggests that the Examiner has failed to establish a *prima facie* case of obviousness for two reasons. The cited references, when combined with the Official Notice taken by the Examiner, fails to teach or suggest all the claim limitations. The necessary teaching or suggestion to make the claim combination and the reasonable expectation of success is not both found in the cited reference. In view of the amendments to independent claim 1 and the associated dependent claims claim 2-9 as well as independent claim 10 and the associated dependent claims 11-14 the Applicant respectfully suggests that Rando '520 when considered individually or together in combination the Official Notice taken by the Examiner, fail to suggest or teach all of the elements of the presently pending amended claims 1-14. For example, amended independent claim 1 describes reimbursing the store for the first and second coupon through the use of the coupon redemption system associated with a third party service provider which is not taught by Rando '520. More precisely, the Applicant believes that Rando '520 fails to teach anything about the process of reimbursing the store from product manufacturers for redeeming coupons. The Examiner has generally stated on pages 3 and 4 of the present Office Action that this part of claim one is found somewhere in the whole document. Applicant respectfully invites the Examiner to more precisely point out to the Applicant where such teaching of each claim element can be found in Rando '520. Claims 2-9 depend from claim 1 and therefore are allowable over Rando '520 for the same reasons that claim 1 is allowable. In addition to the functions described in claim 1, independent claim 10 adds that this coupon redemption system is remotely located from the coupon verification device. Claims 11-14 depend from claim 10 and therefore are allowable over Rando '520 for the same reasons that claim 10 is allowable.

In addition, the Examiner has taken Official Notice with respect to the concepts on reimbursing generally described in present claims 6 and 8. Also, the Examiner has taken Official Notice with respect to the concepts on report generation that includes (i) information related to identity of the store, (ii) an identity of a store lane at which the second coupon was submitted for redemption, and (iii) a time at

which the second coupon was submitted for redemption described in present claim 11. Further, the Examiner has taken Official Notice with respect to the concepts on having check writers and wire transfers to bank accounts associated with the store as generally described in present claim 14. The Applicant respectfully objects to the characterization of what is known and unknown in the art without providing foundation for such a statements based on evidence.

The Court of Appeals for the Federal Circuit recently addressed the evidentiary standard required to uphold an obviousness rejection. Specifically, the Federal Circuit stated that the factual question of motivation is material to patentability, and can not be resolved on subjective belief and unknown authority. In re Lee, 61 USPQ2d 1430, (CAFC 2002) The finding of obviousness must be based upon substantial evidence, and not subjective musings or conjecture by the Examiner. Deficiencies in the evidentiary record cannot be cured by general conclusions such as “general knowledge” or “common sense.” Accordingly, the Examiner cannot rely on unsupported, conclusory statements to close holes in the evidentiary record. Unless the Examiner can establish an evidentiary record based on concrete prior art references that establish that it would have been obvious to a person with ordinary skill in the art to incorporate the features of Applicant’s dependent claims, the claims should be allowed.

In the present patent application, the Examiner has not provided substantial evidence regarding several dependent claims. Therefore, the Applicant respectfully requests that such evidence be provided or this unsubstantiated objections be withdrawn.

Therefore, the rejection of claims 1-14 under 35 USC §103(a) as being unpatentable over Rando ‘520 in view of Official Notice should be withdrawn, because Rando ‘520 fails to teach all elements of the present invention as claimed.

Conclusion

On the basis of the foregoing, Applicant respectfully submits that claims 1-14 are now believed to be in condition for allowance. Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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